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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/787,180 | 05/10/2000 | Helmut Mothes | M0-6241/HR-2 | 7595 |

7590 12/13/2005

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| EXAMINER | |
|---|---|
| COLE, MONIQUE T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1743 | |

DATE MAILED: 12/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/787,180 | MOTHES, HELMUT | |
| | Examiner | Art Unit | |
| | Monique T. Cole | 1743 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *22 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *20-41 and 43-45* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *43 and 45* is/are allowed.

6)☒ Claim(s) *20-41 and 44* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 20-24 are rejected under 35 U.S.C. 102(b) as being anticipated by USP 4,568,560 to Schobel (herein referred to as "Schobel").

Schobel teaches a controlled release encapsulated fragrance with a coating composition that comprises hydrophilic solid particles that comprise ethyl cellulose encasing a fragrance (abstract). Although not specified by Schobel, it is the Examiner's position that the hydrophilic solid particles are capable of having reversible gel formation as temperature increases because the encapsulated particles of Schobel comprise the same ingredients as the encapsulate claimed by Applicant. When the encapsulated particles are added to water, fragrance is released in a time-related manner (col. 7,lines 25-31). Ethyl cellulose is added in an amount of up to 30% of the composition (claim 3). The ethyl cellulose may be coated on the capsules via fluidized bed apparatus (col. 3,lines 3-6). Example II is directed to using the encapsulated fragrances in a detergent. Col. 7,lines 38-61 teaches using the encapsulated fragrance in a chewing gum. Methyl cellulose and hydroxypropyl methyl cellulose are also taught as encapsulating materials (col. 4,lines 41-46 & Example I).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 25-41 & 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schobel.

Schobel teaches a controlled release encapsulated fragrance with a coating composition that comprises hydrophilic solid particles that comprise ethyl cellulose encasing a fragrance (abstract). Although not specified by Schobel, it is the Examiner's position that the hydrophilic solid particles are capable of having reversible gel formation as temperature increases because the encapsulated particles of Schobel comprise the same ingredients as the encapsulate claimed by Applicant. When the encapsulated particles are added to water, fragrance is released in a time-related manner (col. 7,lines 25-31). Ethyl cellulose is added in an amount of up to 30% of the composition (claim 3). The ethyl cellulose may be coated on the capsules via fluidized bed apparatus (col. 3,lines 3-6). Example II is directed to using the encapsulated fragrances in a

detergent. Col. 7,lines 38-61 teaches using the encapsulated fragrance in a chewing gum. Methyl cellulose and hydroxypropyl methyl cellulose are also taught as encapsulating materials (col. 4,lines 41-46 & Example I).

Schobel differs from the instantly claimed invention in that it does not expressly detail whether the fragrance encapsulates are produced by fluidized bed spray granulation. However, Schobel does teach that the spray dried flavors and fragrances are prepared by dissolving in water a solid carrier for the flavor or fragrance oil. The oil is then added to the water solution of carrier with high shear mixing in order to disperse the oil. The dispersion of the oil in carrier solution is then spray dried. The spray dried flavor are of a fine particle size. The coating composition in the carrier vehicle is sprayed into the inlet stream of a fluidized bed in which the flavoring agent or fragrance particles are fluidized. The coating can be applied from an emulsion. Spray dried flavors and fragrances are generally available as fine powders which are granulated to provide particles in the 20-50 mesh range. The disclosed method of granulation utilizes a rotary mixer wherein a solution is added into the powder mix and blended until a uniformly wet granulation develops. The granulated material is then wet screened through a 20 mesh screen, oven dried and re-seived. See col. 2, lines 25-30, 45-60; col. 3, lines 5-7; col. 4, lines 30-51. It is the Examiner's position that this disclosure is a sufficient teaching such that it would have been obvious to one having ordinary skill in the art to perform the process of making a encapsulated aroma and/or perfume such as instantly claimed.

***Response to Arguments***

6. Applicant's arguments, see remarks, filed 9/22/2005, with respect to claims 43 and 45 have been fully considered and are persuasive. The rejections of these claims have been withdrawn.

7. Applicant's arguments filed 9/22/2005 have been fully considered but they are not persuasive.

First, some of Applicant's remarks are unclear, at best. Particularly, page 16, the first full paragraph:

"Applicants would like to point out to the Examiner that it is not obvious to select the method of the present invention, but once the method is selected, the properties of the produced particles are readily apparent; thus, no demonstration of their properties is required."

Next, the crux of Applicant's argument is that the Schobel reference produces particles that are non-spherical agglomerations, whereas the particles of the instant invention are spherical. Applicant supplied non-English technical documents to substantiate this position.

However, the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include ***statements regarding unexpected results***, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. Affidavits or declarations, when timely presented, containing ***evidence of criticality or unexpected results***, commercial success, long-felt but unsolved needs, failure of others, skepticism of experts, etc.,

***must be considered by the examiner in determining the issue of obviousness of claims for patentability under 35 U.S.C. 103***. See MPEP 716.01.

**The mere mention of references in the remarks is NOT a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.**

**Additionally, the Examiner is surprised at having been instructed on page 13, paragraph 3 of Applicant's remarks, "to take the above-indicated documents to a German translator within the USPTO, to verify the authenticity of the Applicants arguments." The Examiner respectfully denies this unconventional request and reminds Applicant of her own duty to supply a translation.**

***Allowable Subject Matter***

**8.** Claims 43 & 45 are allowed.

***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique T. Cole whose telephone number is 571-272-1255. The examiner can normally be reached on Monday, Tuesday & Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. T. Cole

Monique T. Cole
Primary Examiner
Art Unit 1743

mtc